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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,065	11/09/1999	BALAS N. KAUSIK	028410-0009	7488

7590

04/10/2003

SKADDEN ARPS SLATE MEAGHER AND FLOM LLP  
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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/437,065

Applicant(s)

Balas N. Kausik

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01/21/2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**  
**RESPONSE TO AMENDMENT**

1. This Office action is in response to Applicant's amendment filed on 01/21/2003.
2. Claims 1-65 are pending.
3. The rejection to claims 1-65 under 35 U.S.C. 102 (e) as being anticipated by Slater (U.S. Pat. No. 6,098,053) as set forth in the Office action mailed on 10/29/2002 is maintained.

***Claim Rejections - 35 USC § 102***

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. **Claims 1-65, are rejected under 35 U.S.C. 102 (e) as being anticipated by Slater (U.S. Pat. No. 6,098,053).**

As per claims 1, 2, 10-15, 23, 24, 25, 26, 27, 28, 29, 30, 33, 34, 37, 38, 41, 42, 45, 46, 53, 54, 55, 56, 57, 58 and 59-65 discloses a system/method for performing an on-line ATM/POS transaction utilizing checking or savings account funds over a public access network. An electronic financial transaction instruction comprising card information and security information that are

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encrypted for secure transmission over the public access network. The card information identifies a checking or savings account number of a purchaser (which is seen to read as Applicant's claimed invention wherein it is stated that a method for authorizing an electronic purchase in a networked computer environment), the method comprising the steps of:

receiving from a merchant, a transaction authorization request including a digital certificate passed through said merchant from a user involved in said transaction (see., abstract);

said certificate including a financial account datum associated with said user, at least a portion of which is confidential from said merchant (see., col 4, lines 32-65);

(said digital certificate conveying a binding between at least a portion of said financial account datum and a public key of said user (see., col 4, lines 32-65, it is inherent to realize that encryption also includes public and private keys);

verifying said binding using a cryptographic verification key associated with a trusted party performing said binding (see., abstract, col 4, lines 32-65, it is inherent to realize that encryption (or cryptographic) also includes public and private keys, and col 5, lines 40-67); and

using said financial account datum to authorize a transaction order digitally signed by said user with a private key corresponding to said public key (see., abstract, col 4, lines 32-65, col 5, lines 40-67, it is inherent to realize that encryption also includes public and private keys or symmetric key or asymmetric key).

**As per claims 3-6, 8, 9, 16-19, 21, 22, 32, 36, 40, 44, 47, 48, 49, 50, 52, Slater** discloses the claimed method, where said digital certificate constitutes said binding (see., col 4, lines 32-65).

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As per claims 7, 20, 31, 35, 39, 43, 51, Slater discloses the claimed method, where said financial account datum includes a PIN (see., col 2, lines 1-18).

### **RESPONSE TO ARGUMENTS**

6. Applicant's arguments filed on 01/21/2003 have been fully considered but they are not persuasive.

### **REMARKS**

7. In response to Applicant's representative arguments, Applicant's representative argues that the prior art of record (Slater )does not disclose the term:

a. "digital certificate". However, the Examiner respectfully disagrees with the Applicant's representative because this limitation is disclosed by Slater in col 8, lines 29-51, specifically wherein it is stated that secure mechanism may comprise one or more a combination of the following operations on PURCHASER payment instructions: symmetric encryption, asymmetric encryption, a purchaser's verifiable digital signature and a verifiable DIGITAL CERTIFICATION. Applicant should duly note that this digital certification is for the user not for the merchant.

b. "Conveying a user's digital certificate to a transaction processor via a merchant". As specify by the Examiner in the Office action mailed on 5/17/2002, this limitation is disclosed by Slater in col 4, lines 32-65, specifically wherein it is stated that a digital certificate of the merchant may be appended to the financial transaction instructions, where the merchant's digital certificate provides additional verification of the merchant's identity and the integrity of the financial transaction instructions, please note that this digital certificate is conveyed from the user or purchaser to the merchant.

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c. "Cryptographically binding the user's public key to a portion of the user's account information".

As specified by the Examiner in the Office action mailed on 5/17/2002, this limitation is disclosed by Slater in col 4, lines 32-65, it is inherent to know that encryption or cryptographic also includes public and private keys, and col 5, lines 40-67.

In response to Applicant's amendment filed on 01/21/2003, Applicant argues that Slater's digital certificate is the merchant's digital certificate, whereas the claimed digital certificate (that is conveyed to the transaction processor via the merchant) is the user's digital certificate. Examiner respectfully disagrees, as Slater discloses a digital certificate that may also be used to provide verification of the identity of the sender (sender or user or purchaser's verifiable digital certificate), as well as providing the sender's public key for use in sending an encrypted response back to the sender (see., col 8, lines 29-51, col 9, lines 13-48). Therefore, Applicant's arguments are moot.

### **CONCLUSION**

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

Commissioner of Patents of Trademarks

Washington, D.C. 20231

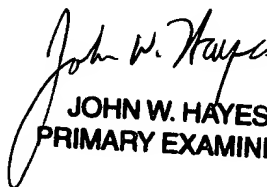
The Official Fax Number For TC-3621 is:

(703) 305-7687

  
Pierre Eddy Elisca

Patent Examiner

**March 27, 2003**

  
JOHN W. HAYES  
PRIMARY EXAMINER